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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,592	01/14/2002	R. Michael Gross		3738

7590 12/01/2004

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/046,592	<b>Applicant(s)</b> GROSS, R. MICHAEL	
	<b>Examiner</b> Brian E Pellegrino	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 September 2004 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **26'**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kater (5046509). Fig. 1 shows a tool having an elongated tube **100** with an outer surface and a proximal end that may be placed in communication with a suction mechanism. It can also be seen there is a sleeve **112** that is slidably coupled to the outer surface of the elongated tube. Additionally, Kater discloses a gasket **108** operatively coupled at the

distal end of the sleeve and positioned to provide a seal between the tube and the sleeve. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of being inserted through the coracoid process and the gasket being shaped and sized for selective sealing engagement with the coracoid process. It can also be seen the distal end of the tube has an angular portion **102**.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Kramer et al. (4969870). Fig. 2 shows a tool having an elongated tube **15** with an outer surface and a proximal end that may be placed in communication with a suction mechanism. It can also be seen there is a sleeve **19** that is slidably coupled to the outer surface of the elongated tube. Additionally, Kramer discloses a sealing surface **21** at the distal end of the sleeve that can be positioned to seal a bone cavity. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of drawing material into a body cavity by forming a negative pressure and suction.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kater '509 in view of Lee et al. (5693030). Kater is explained supra. However, Kater fails to disclose openings in the tip of the tube and an obturator. Lee et al. teach (Fig. 1) a tube

with a distal portion having a plurality of openings **32** therein for greater communication with the channel in the tube. Lee also teaches (Fig. 3) an obturator **60** that may be extended in the tube that is fully capable of clearing debris. It would have been obvious to one of ordinary skill in the art to use a plurality of openings in the end of the tube and an obturator as taught by Lee et al. with the tool of Kater such that greater suction or pressure can be created with more openings and the obturator provides the ability of the surgeon to free up any debris accumulation that would block the flow of material being removed.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kater '509 in view of Dubinsky (WO 99/52441). Kater is explained supra. However, Kater fails to disclose the end of the tube having an arcuate portion. Dubinsky teaches (Fig. 1) an elongated tube **125** having an arcuate portion that enables the device to be placed within a curved cavity. It would have been obvious to one of ordinary skill in the art to use an arcuate portion as taught by Dubinsky with the tool of Kater such that the surgeon has more maneuverability with the tool and less likely to damage tissue when approaching a cavity that is not in the direct path of the tool.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

Primary Examiner

Brian E. Pellegrino

A handwritten signature in cursive script that reads "Brian E. Pellegrino". The signature is written in dark ink and is positioned below the printed name.